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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,528	05/18/2006	Hisashi Maeshima	3273-0207PUS1	5366

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EXAMINER
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OJURONGBE, OLATUNDE S

ART UNIT	PAPER NUMBER
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1796

NOTIFICATION DATE	DELIVERY MODE
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09/04/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/540,528	<b>Applicant(s)</b> MAESHIMA, HISASHI	
	<b>Examiner</b> OLATUNDE S. OJURONGBE	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05/26/2009 and 06/22/2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 7-15 is/are pending in the application.
- 4a) Of the above claim(s) 1,2,11 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3,7-10,12,14 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. The amendment filed on 05/26/2009, and the supplemental correspondence filed on 06/22/2009 have been entered.
2. Claims 1-3 and 7-15 are pending in the application.
3. The restriction requirement remains as set forth in prior office action. The two inventions lack unity of invention as explained in prior office action. Concerning the applicant's argument that the compositions of Group I and/or Group II are novel and non-obvious and that they possess a common special technical feature, which involves incorporation of the specified surfactant into the compositions, the examiner notes that the common special technical feature claimed by the applicant is neither novel or non-obvious as explained in the rejection below, therefore the compositions of Group I and Group II are without a common special technical feature.

### ***Election/Restrictions***

4. Newly submitted claims 11 and 13 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 11 and 13 depend on non-elected claims 1, 2 and/or 11. Claims 11 and 13 are independent or distinct from the elected claims as explained in prior office action for claims 1, 2 and/or 11.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 1-2, 11 and 13 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

5. The examiner notes that the applicant chose to withdraw claims 7-10, however, since claim 7 could depend on claim 3, claims 7-10 are rejected as set forth below.

#### ***Claim Objections***

6. Claim 7 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim does not refer to a preceding claim. See MPEP § 608.01(n). Dependent claims 8-10 are rejected to for the same reasons. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. **Claims 3, 7-10, 12 and 14-15** are rejected under 35 U.S.C. 102(b) as being anticipated by **Yamamura et al (WO 01/95030)**, as evidenced by **Hattori et al (US 5,773,194)**, as further evidenced by **Igarashi et al (US 5,336,574)**.

Art Unit: 1796

The rejection of claim 3 remains as set forth in the prior office action. Regarding the amendment to the claim, Yamamura et al further exemplifies compositions of comparative Example 3 and 5 comprising bis (3,4-epoxycyclohexylmethyl)adipate, a cationic photoinitiator, and polyflow ATF and MEGAFAC F-179 respectively (page 39, lines 1-8 and 20-26).

Polyflow ATF(silicone-type defoaming agent) and/or MEGAFAC F-179 meets the limitations of the surfactant of the instant claim. (see Hattori et al, col.7, lines 37-40, and Igarashi et al, col.4, lines 64-68).

Regarding **claims 12 and 14**, the exemplified 25 parts by weight of bis (3,4-epoxycyclohexylmethyl)adipate and 0.1 part by weight of polyflow ATF of Yamamura et al meets the claim limitations.

Regarding **claims 12 and 15**, the exemplified 25 parts by weight of bis (3,4-epoxycyclohexylmethyl)adipate and 0.1 part by weight of MEGAFAC F-179 of Yamamura et al meets the claim limitations.

### ***Claim Rejections - 35 USC § 103***

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Art Unit: 1796

10. **Claims 3, 7-10, 12 and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Fujiwa et al (US 5,378,736)** in view of **Takai (JP 2002-338659, US 2003/0059618** is used for ease of citation).

The rejection of claims 3 and 7-10 remains as set forth in prior office action.

Regarding **claims 12 and 14**, modified Fujiwa et al further teaches using 0.01 to 5 parts by weight of the silicon wax based on 100 parts by weight of the epoxy compound [see Takai, 0167].

11. **Claims 3, 7-10, 12 and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Barbe et al (EP 0736555)** in view of **Takai (JP 2002-338659, US 2003/0059618** is used for ease of citation).

The rejection of claims 3 and 7-10 remains as set forth in prior office action.

Regarding **claims 12 and 14**, modified Barbe et al further teaches using 0.01 to 5 parts by weight of the silicon wax based on 100 parts by weight of the epoxy compound [see Takai, 0167].

### ***Response to Arguments***

12. Applicant's arguments filed on 05/26/2009 have been fully considered but they are not persuasive.

Art Unit: 1796

The applicant provides a comparison chart of the present application, Fujiwa, Barbe and Takai, and argues that surfactants are not mentioned in the primary references. In response to this, the examiner notes that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Furthermore, as mentioned in prior office action, and reiterated above, since the inventions of Takai and Fujiwa/ Takai and Barbe are in the same field of endeavor, motivated by the advantages of the lubricity-imparting agent of Takai, it would have been obvious to one of ordinary skill in the art to have incorporated any of the lubricity-imparting agents, including BYK-330, of Takai into the composition of Fujiwa/ Barbe.

The applicant further argues that the composition of applicant's Example 1 and 2 showed remarkable effect of warping and that in contrast, while Takai teaches that silicon-based defoamers (surfactants) can be added to liquid epoxy resin, Takai provides no description of a desirable relevant concrete effect which could be obtained by using such surfactants. In response to this, the examiner notes that the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

The applicant further argues that the purpose provided by Takai for the lubricity-imparting agent is a "shot gun" disclosure and does not provide a rationale for modifying

Art Unit: 1796

Fujiwa or Barbe. In response to this, the examiner notes that the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). One of ordinary skill in the art would have combined Takai and Fujiwa/Barbe as explained in prior office action, and reiterated above.

The applicant further argues that Takai teaches that an epoxy resin composition comprising an alicyclic epoxy compound not having an ester linkage can overcome the problem sought to be solved by the Takai invention, and in contrast, the present application provides a heat-curable resin composition comprising an alicyclic epoxy compound having a polyester chain, which provides a significant improvement in warping of a flexible film made therefrom, and the present application also teaches that having a polyester chain in the composition is a significant feature. In response to this, the examiner notes that the rejection of the instant claims is based on a combination of references, and one cannot show nonobviousness by attacking references individually, where the rejections are based on combinations of references. Furthermore, the examiner notes that the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious.

The applicant's arguments have failed to put the application in a condition for allowance.

***Conclusion***

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLATUNDE S. OJURONGBE whose telephone number is (571)270-3876. The examiner can normally be reached on Monday-Thursday, 7.15am-4.45pm, EST time, Alt Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571)272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1796

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

O.S.O.

/Randy Gulakowski/  
Supervisory Patent Examiner, Art Unit 1796